

Appl. No. 09/022,132
Amendment and/or Response
Reply to Office action of 16 February 2004

Page 6 of 9

REMARKS

Claims 1-4 and 6-20 are pending in this application.

The final Office action rejects claims 1, 3, 4, 6, 8, 10, 12, 14, 15, 17, and 19 under 35 U.S.C. 102(b) over Sitrick (USP 4,521,014). The applicant respectfully traverses this rejection.

Claim 1, upon which claims 2-4, 9, and 15-16 depend, claims a method for operating a multi-player video game, that includes displaying the video image of the currently high-scoring player of the multiple players in a predefined field associated with the gaming environment that is configured to contain the video image of the currently high-scoring player during the particular session of the video game.

Claim 6, upon which claims 7-8 and 17-18 depend, claims a video game system that includes a display that is configured to display the video image of the currently high-scoring player in a predefined field that is configured to contain the image of the currently high scoring player during the particular session of the video game.

Claim 10, upon which claims 11-14 and 19-20 depend, claims a method for operating a multi-player video game that includes displaying a video image of one of the multiple players that has the currently highest performance level of the multiple players in a field of a display that is configured to contain an image of a highest performing player during the particular session of the video game.

The Examiner's attention is requested to MPEP 2131, wherein it is stated:

"A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The *identical invention* must be shown in as *complete detail* as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Sitrick does not teach displaying the video image of the currently high-scoring player in a predefined field associated with the gaming environment during the particular session of the video game, as specifically claimed in each of the applicant's independent claims 1, 6, and 10.

Appl. No. 09/022,132
Amendment and/or Response
Reply to Office action of 16 February 2004

Page 7 of 9

The final Office action asserts that Sitrick teaches displaying the video image of the currently high-scoring player in a predefined field associated with the gaming environment during the particular session of the video game, at page 2, lines 18-21 of the final Office action, but provides no reference to Sitrick for this teaching. The Office action asserts that "the game screen is a predefined field associated with the gaming environment that is configured to contain the video image of the currently high-scoring player". The applicant respectfully maintains that the entire game screen cannot be said to be "a predefined field that is configured to contain the video image of the currently high-scoring player" without obviating the meaning of the terms in the claimed element. The term "predefined field" has an inherent meaning in the field of art of the applicant's invention, which does not include an entire display screen, as the Office action's interpretation would imply. Sitrick is silent with regard to a predefined field that is configured to contain an image of a currently high-scoring player, is silent with regard to providing an image of a currently high-scoring player, and is silent with regard to providing such an image in such a predefined field.

The Office action asserts that Sitrick teaches displaying the image of all players at column 11, lines 40-51, and thus the high-scoring player must be displayed in a predefined field. The applicant respectfully notes, however, that the cited text of Sitrick is silent with regard to displaying images of "all players", as asserted in the Office action.

Because Sitrick fails to teach displaying the video image of the currently high-scoring player in a predefined field that is configured to contain the video image of the currently high-scoring player during the particular session of the video game, as specifically claimed in each of the applicant's independent claims 1, 6, and 10, the applicant respectfully requests the Examiner's reconsideration of the rejection of claims 1, 3, 4, 6, 8, 10, 12, 14, 15, 17, and 19 under 35 U.S.C. 102(b) over Sitrick.

Appl. No. 09/022,132
Amendment and/or Response
Reply to Office action of 16 February 2004

Page 8 of 9

The final Office action rejects:

claims 2, 7, and 11 under 35 U.S.C. 103(a) over Sitrick and Breslow et al. (USP 4,710,873, hereinafter Breslow);

claims 9 and 13 under 35 U.S.C. 103(a) over Sitrick, Weiss (USP 5,821,983) and Hogan et al. (USP 5,657,246); and

claims 16, 18, and 20 under 35 U.S.C. 103(a) over Sitrick and Meyer et al. (USP 4,508,353).

The applicant respectfully traverses these rejections.

The Examiner's attention is requested to MPEP 2142, wherein it is stated:

"To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) *must teach or suggest all the claim limitations*." Further: "The examiner bears the initial burden of factually *supporting* any *prima facie conclusion* of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

In each of the above rejections, the Office action relies upon Sitrick for teaching the elements of the independent claims 1, 6, and 10, upon which each of these rejected claims depend.

As noted above, Sitrick does not teach the elements of claims 1, 6, and 10, and specifically does not teach displaying the video image of the currently high-scoring player in a predefined field that is configured to contain the video image of the currently high-scoring player during the particular session of the video game, as specifically claimed in each of the applicant's independent claims.

Because the Office action fails to support a *prima facie* conclusion of obviousness in the above rejections, the applicant respectfully requests the Examiner's reconsideration of the above rejections under 35 U.S.C. 103(a).

Appl. No. 09/022,132
Amendment and/or Response
Reply to Office action of 16 February 2004

Page 9 of 9

In view of the foregoing, the applicant respectfully requests that the Examiner withdraw the rejections of record, allow all the pending claims, and find the present application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Robert M. McDermott, Esq.
Reg. No. 41,508
804-493-0707